



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,818	08/13/2001	Leland F. Wilson	9050-0013.24	9897

23980 7590 07/25/2003

REED & EBERLE LLP
800 MENLO AVENUE, SUITE 210
MENLO PARK, CA 94025

EXAMINER

CHISM, BILLY D

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 07/25/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,818

Applicant(s)

WILSON ET AL.

Examiner

B. Dell Chism

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1654

Response to Amendment

1. The reply, filed on 04 April 2003, is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Applicants failed to elect one invention from Set I (inventions 1-204) or Set II (inventions 205-408). However, Applicants did elect Set I but failed to elect a patentably distinct invention from Set I. Furthermore, Applicants traversed the restriction requirement, and failed to answer the requirement that *"If Applicants wish for more than a single sequence identification number to be searched for either Set I or Set II, Applicants can provide the following information. If Applicants can demonstrate that two or more polypeptides having SEQ ID NO: 2-205 are related such that a single subsequence found within a specific sequence identification number can be searched, Applicants are encouraged to additionally point out this subsequence that can be found within two or more polypeptides. Applicants should list the specific sequence identification numbers in which the subsequence can be found. This subsequence must be of sufficient length such that data base search of the subsequence will identify any pertinent art that may anticipate or render obvious the specified sequences listed by Applicants. Only one sequence will be searched; therefore, if a subsequence is requested for search, all sequences stated by Applicants to comprise this subsequence will be considered obvious over any art anticipating the subsequence."* See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

Art Unit: 1654

Below is a restatement of the previous restriction requirement, Paper No. 13 filed 04 April 2003:

DETAILED ACTION

This Office Action is in response to Paper No. 12 filed 06 January 2003, wherein Applicants made an election of Group I, claims 1-28. Upon further consideration of the previously filed Restriction Requirement, Paper No. 10 filed 30 October 2002, the Examiner finds it necessary to withdraw the previous restriction and apply the following new restriction to more clearly identify the claimed invention.

Election/Restrictions

I. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Set I:

Inventions 1-204, Claims 1-28, drawn to a method of treating female sexual disorders comprising administering any one of SEQ ID NOs: 2-205, respectively, class 514, subclass 537.

Inventions 1-204 are drawn to methods comprising the use of polypeptides, SEQ ID NOs: 2-205, having differing structure and therefore differing function. These polypeptides are considered to be patentably distinct one from the other and therefore any method comprising use of differing amino acid sequences (different ingredients) is patentably distinct. If any one of Inventions 1-204 is elected, the elected invention will be examined only in so far as it pertains to the elected polypeptide.

Set II:

Inventions 205-408, Claims 29-40, drawn to polypeptide compositions comprising any one of amino acid sequences of SEQ ID NOs: 2-205, respectively, class 514, subclass 537.

Inventions 205-408 are drawn to polypeptides having differing structure and therefore differing function. These polypeptides are considered to be patentably distinct one from the other. If any one of Inventions 205-408 is elected, the elected invention will be examined only in so far as it pertains to the elected polypeptide.

Art Unit: 1654

2. *If Applicants wish for more than a single sequence identification number to be searched for either Set I or Set II, Applicants can provide the following information. If Applicants can demonstrate that two or more polypeptides having SEQ ID NO: 2-205 are related such that a single subsequence found within a specific sequence identification number can be searched, Applicants are encouraged to additionally point out this subsequence that can be found within two or more polypeptides. Applicants should list the specific sequence identification numbers in which the subsequence can be found. This subsequence must be of sufficient length such that data base search of the subsequence will identify any pertinent art that may anticipate or render obvious the specified sequences listed by Applicants. **Only one sequence will be searched;** therefore, if a subsequence is requested for search, all sequences stated by Applicants to comprise this subsequence will be considered obvious over any art anticipating the subsequence.*

3. *The inventions are distinct, each from the other because:*

The inventions of Set II and Set I are distinct inventions as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be use in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein inventions of Set II can be used for immunoassays, antibody production, binding assays, molecular weight marker, etc...

The method inventions of Set II are distinct wherein the different methods comprise use of different ingredients.

The product inventions of Set I are distinct that the products are structurally and functionally different.

Art Unit: 1654

4. *Because these inventions are distinct for the reasons given above and the search required for Set I is not required for Set II, and because the search required for one invention of Set I is not required for the other inventions of Set I, and because the search required for one invention of Set II is not required for the other inventions of Set II, restriction for examination purposes as indicated is proper.*


5. *Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. Dell Chism whose telephone number is 703-306-5815. The examiner can normally be reached on 7:30 AM - 4:30 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 703-306-3220. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

B. Dell Chism
17 July 2003


BRENDA BRUMBACK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600